

### **REMARKS**

Claims 1-13 are now pending in the application.

Minor amendments have been made to the claims to simply overcome the objections to the claims under 35 U.S.C. § 112. The claims contained herein are of equivalent scope as originally filed. Therefore, this amendment is not a narrowing amendment.

If the Examiner relies on a new ground of rejection or a new reference in rejecting the Claims in the next Office Action, a Final Office Action would not be appropriate since the amendments to the claims do not change the scope of the claims. Under present practice, second or subsequent actions on the merits shall be final, except where the Examiner introduces a new ground of rejection that is not necessitated by Applicants' amendment of the claims. **See MPEP § 706.07(a).**

The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

### **REJECTION UNDER 35 U.S.C. § 112**

Claims 1-13 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

The Examiner asserts that the claim limitation "a fastener that is associated with at least one of said lotion impregnated sheet and said applicator body" is unclear. While Applicants respectfully disagree with this rejection, Applicants have amended Claims 1

and 7 to include the Examiner's proposed changes. Applicants reserve the right to pursue the claims as originally filed in one or more continuing applications.

The Examiner also suggests that the word "associated" is unclear. Applicants respectfully disagree and assert that the term is in fact clear. For example, Merriam-Webster (for example, see <http://www.merriam-webster.com/dictionary/associate>) defines the term associated to mean "to join or connect together, combine". It is abundantly clear that Applicants have used the term in a manner that is consistent with its ordinary meaning. Therefore, this rejection is respectfully traversed for at least this reason.

Applicants respectfully assert that the rejections under 35 U.S.C. § 112 are moot.

#### **REJECTION UNDER 35 U.S.C. § 103**

Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Steinberg et al. (U.S. Pat. No. 6,981,293) in view of Brower et al. (U.S. Patent No 6,250,829). This rejection is respectfully traversed.

With respect to Claim 1, Steinberg et al. and Brower et al. do not at least show, teach or suggest a lotion applicator comprising a sheet that is impregnated with lotion and that is removably attached to a body.

Furthermore, Applicants respectfully assert that it would not be obvious to combine Steinberg et al. and Brower et al. since both Steinberg et al. and Brower et al. teach away from the claimed invention.

As best understood by Applicants, Steinberg et al. is directed to a device for cleansing and removal of debris from excretory and vaginal orifices and surrounding

areas. Steinberg et al. teaches a cleaning attachment that is relatively **flat** to allow insertion into the excretory and vaginal orifices. Disposable cleaning sheets are attached to the flat cleaning attachment and are used exclusively for cleaning. When cleaning is finished, Steinberg et al. **removes** the cleaning attachment and attaches a roller applicator as shown in FIG. 7 to apply lotion. The lotion is applied using the refillable roller applicator<sup>1</sup>.

By expressly teaching the use of the refillable roller applicator for lotion application, Steinberg et al. expressly **teaches away** from using disposable sheets impregnated with lotion. When one of the applied references teaches away from making a particular combination of known elements, the combination is likely to be non-obvious. **KSR Int'l v. Teleflex Inc.**, 550 U.S. \_\_\_\_ (2007).

Furthermore, the roller applicator of Steinberg et al. has many of the disadvantages of the prior art that were discussed in paragraphs [0005]-[0006] of Applicants disclosure. For example, the lotion in the refillable roller applicator tends to dry when not in use, which tends to clog the device. Changing the type of lotion in the applicator requires removal, cleaning, refilling and re-attachment, which can be time consuming. The claimed lotion-impregnated disposable sheets lack these disadvantages.

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<sup>1</sup> In FIG. 8 and the corresponding description, Steinberg et al. refers to a "disposable sheet" that can be attached to a body. (Steinberg et al. at Column 3, line 20). The disposable sheet is used for cleaning and removal of debris – not applying lotion. There is no teaching or suggestion anywhere in Steinberg that the disposable sheet is impregnated with lotion.

While Steinberg et al. refers to the impregnation of the handle or body with anti-bacterial material (Steinberg, Col. 2, line 29), this is not the same as or similar to the impregnation of disposable sheets with lotion. While the body or handle may include antibacterial material, the disposable sheets are not impregnated with antibacterial material. Furthermore, antibacterial material is not lotion.

Additional problems may arise by using the proposed refillable roller applicator in Steinberg et al. A head of the roller applicator is arranged in a direction that is parallel to the handle. Therefore, it would be difficult to orient the roller applicator correctly to apply lotion to a person's back. The roller would simply not be in a suitable orientation without requiring a person's arm to be contorted at a very awkward angle.

Therefore, Steinberg et al. teaches away from the use of lotion-impregnated disposable sheets for applying lotion. As a result, it would not be obvious to combine Steinberg et al. with another reference to reject Claim 1 since Steinberg et al. proposes an inconsistent approach. See KSR Int'l v. Teleflex Inc..

The lotion applicator of Brower et al. also teaches away from the claimed combination. Brower et al. is intended to be worn on a user's hand. Therefore using a body and handle is inconsistent with the express teachings of Brower et al. There is no teaching or suggestion in Brower et al. that the lotion applicator of Brower et al. can be attached to a handle and/or a body using a fastener as claimed by Applicants.

Furthermore, Brower et al. emphasizes portability of the device. In other words, Brower et al. was designed to be small so that it can be easily carried. Therefore it is inconsistent to suggest that it would be obvious for one skilled in the art to combine the Brower et al. device with the more cumbersome arrangement described in Steinberg et al. since this would conflict with the express teachings of Brower et al.

Even if the Examiner incorrectly concludes that the teachings of Steinberg et al. or Brower et al. do not rise to the level of teaching away, the proposed combination is improper for other reasons. Applicants respectfully assert that the Examiner has

misapplied these references and used incorrect hindsight in making the proposed combination. A reference must be considered for all that it teaches including disclosures that point towards the invention and disclosures that teach away from the invention. In re Dow, 5 USPQ.2d 1529 (Fed. Cir. 1988). Steinberg et al. uses a refillable lotion applicator and not lotion-impregnated disposable sheets for applying lotion. Brower et al. does not disclose attaching the lotion applicator described therein to a body – and stresses the portability of the device. It is improper to take teachings in the prior art out of context and give them meanings that they would not have to those skilled in the art. In re Wright, 9 USPQ.2d 1649 (Fed. Cir 1989). It is impermissible to pick and choose from a reference on so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what the reference fairly teaches to one skilled in the art. Bausch & Lomb, Inc. v. Barnes-Hind, Inc., 230 USPQ 416 (Fed. Circ. 1986). Applicants have pointed out significant flaws in the Examiner's proposed combination based on other inconsistent teachings of the applied references. Therefore, Applicants respectfully assert that the proposed combination is improper for at least these reasons.

Claim 1 is allowable over Steinberg et al. and Brower et al. for at least these reasons. Claim 7 is allowable over Steinberg et al. and Brower et al. for at least similar reasons as Claim 1. Claims 2-6 and 12 and 8-11 and 13 are dependent on Claims 1 and 7, respectively, and are allowable for at least similar reasons.

Applicants respectfully assert that the Examiner is not entitled to ignore limitations of the claims. The Examiner incorrectly states that "Applicant is reminded

that where the general conditions of the claims are met, burden is shifted to the Applicant to provide a patentable distinction". Applicants respectfully request that the Examiner provide legal support in subsequent Office Actions for this incorrect statement of law.

Even assuming for the sake of argument that the Examiner is correct, Applicants rebutted the Examiner's incorrect legal assertion in the last response and therefore the burden has shifted back to the Examiner to show all of the limitations of Claim 6 and other claims in this application. It is a longstanding rule that to establish a prima facie case of obviousness of a claimed invention, **all of the claim limitations** must be taught or suggested by the prior art. **In re Royka**, 180 USPQ 143 (CCPA 1974), see MPEP §2143.03. Furthermore, when evaluating claims for obviousness under 35 U.S.C. §103, all of the limitations must be considered and given weight. **Ex parte Grasselli**, 231 USPQ 393 (Bd. App. 1983), MPEP § 2144.03.

At least with respect to Claim 6, Applicants rebutted the Examiner's unsupported legal position and pointed out patentable distinctions. In particular, Steinberg et al. fail to show, teach or suggest the applicator body includes a top surface having an arcuate cross section and a bottom surface having a substantially planar surface. Brower et al. is silent on this issue since Brower et al. does not disclose a body and supports the lotion applicator with a user's hand.

Since Steinberg et al. is directed to a device for cleansing and removal of debris from excretory and vaginal orifices and surrounding areas, Steinberg et al. discloses planar top and bottom surfaces that are **parallel**. This relatively flat, parallel-wall design would appear to allow the device of Steinberg et al. to be positioned in these tight

locations. In other words, the shape of the body in Steinberg et al. is more anatomically correct for removal of debris from these locations (excretory and vaginal orifices and surrounding areas). The shape of the body recited in Claim 6 would probably not work.

The arcuate cross section of Applicants' lotion applicator provides an anatomically correct profile for Applicants' intended use. **For example only, the arcuate cross section of Applicants' lotion applicator enables the user to evenly apply a topical lotion to the curves and contours of the shoulder and back areas (but not limited to these areas).** These areas have curved profiles. The flat profile disclosed in Steinberg et al. would not work nearly as well when applying lotion.

Furthermore, the flat attachment device and disposable sheets of Steinberg et al. **are not used** to apply lotion as in Applicants invention. Rather, the roller applicator in Steinberg et al. is used to apply lotion.

Therefore, Claim 6 is allowable for at least these reasons. Claims 11, 12 and 13 are allowable for at least similar reasons as Claim 6.

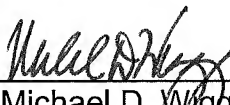
### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner

believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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By:   
Michael D. Wiggins  
Reg. No. 34,754

MICHAEL D. WIGGINS  
950 Harmon  
Birmingham, Michigan 48009  
(248) 641-1211